

Application No.: 09/932,910
Response dated August 18, 2004
Reply to Office Action of May 20, 2004

REMARKS

Reconsideration of the present claims, in light of the attached claim clarifications and the Remarks, which follow, is respectfully requested.

Claims now before the Examiner are 1-2, 4-13, and 15-36.

The numbering in this response will follow that of the Examiner's Action of May 20, 2004.

1. No response necessary.

Rejections Under 35 USC § 112

2. *Claims 1, 2 and 4-13 and 15-36 stand rejected under 35 USC § 112, Second Paragraph*

Applicants respectfully submit that the amended claims 1, 2, 12, 29 and 30 address this Rejection, with the exceptions noted below.

In claim 1, line 8, R¹, should not be included with R², R⁴ and R⁵.

In claim 1, lines 22-24 and the last line of the claim, the ortho carbon appears to be correctly synched with the verb.

In claim 12, the same issues above are found in claim 12.

Withdrawal of the Rejections is respectfully requested.

Rejections Under 35 USC § 103

3. & 4. *Claims 1, 2, 4-13, and 15-36 stand rejected as Obvious over US 4,981,931 (Bell I), US 5,840,646 (Katayama), Applied Catalysis, Vol. 22, pp. 345-359 (1986) (Coleman), EP 0 259 215 (Basset), US5,319,042 (Bell II), US 4,729,976 (Sjardin), and Chem. Abstracts, vol. 131, no. 8, abstract # 102661 to Matsui, et. al (Matsui).*

The Examiner states:

However, none of these references clearly disclose that substitution of different heteroatoms or numbers of methylene groups in a polymethylene chain would have been beneficial. ...Nevertheless, it would have been within the skill of the routineer in the art to

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make these simple changes in the molecules of the prior art to arrive at the present invention.... It would have been obvious to one of ordinary skill to apply the disclosures of any of the primary references with a reasonable expectation of obtaining a highly useful catalyst with the expected benefit of greater flexibility in choice of starting materials for the transition metal portion of the catalyst.

In making this Rejection, the Examiner is ignoring that: a) for assertions of this type, Applicant can request evidence, not mere allegations of Obviousness, and Applicants are requesting such evidence; b) Applicants do not find any motivation for "substitution of different heteroatoms or numbers of methylene groups in a polymethylene chain" in the documents individually or collectively, and none was pointed out by the examiner, motivation to combine documents or motivation to change one or more elements of the reference(s) must be found in the documents, and no such evidence was located or pointed to by the Examiner; c) the term "to apply the disclosures of any of the primary references with a reasonable expectation of obtaining a highly useful catalyst with the expected benefit of greater flexibility in choice of starting materials for the transition metal portion of the catalyst" amounts to an "obvious to try" Rejection, and is not a permissible basis for an Obviousness Rejection.

Furthermore, in another case (USSN 09/998,855) the Examiner has stated "... in an inherently uncertain field like chemistry, let alone catalysis, " so in such an unpredictable field, such "substitution of different heteroatoms or numbers of methylene groups in a polymethylene chain" there is no evidence that such substitutions would yield a predictable result to the Examiner's hypothetical routineer. Accordingly, the combination of the references does not render Applicants' claims Obvious.

Withdrawal of the Rejection is respectfully requested.

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SOUTHWEST PATENT SVS

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All of the Examiner's Rejections have been addressed.

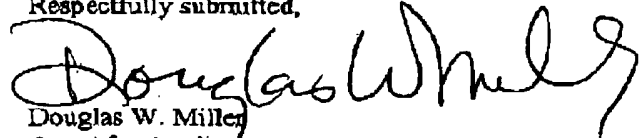
The claims are in condition for allowance.

Note is made that the correspondence should be sent to:

Douglas W. Miller
In representation of Univation Technologies, LLC
c/o Stephen P. Koch
5555 San Felipe, Suite 1950
Houston, Texas 77056
Facsimile: 713.892.3687

However the telephone number for Douglas W. Miller is (713) 780-7799.

Respectfully submitted,


Douglas W. Miller
Agent for Applicants
Registration No. 36,608

Southwest Patent Services
510 Bering Drive, Suite 300
Houston, Texas 77057
(713) 780-7799

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

August 18, 2004

Date


Douglas W. Miller
Registration No. 36,608

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